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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/663,918	09/16/2003	Richard A. Wilsak	37,512	2288
7590	03/25/2010		EXAMINER	
BP America Inc. Docket Clerk, BP Legal, M.C. 5East 4101 Winfield Road Warrenville, IL 60555			POPOVICS, ROBERT J	
		ART UNIT	PAPER NUMBER	
		1797		
			MAIL DATE	DELIVERY MODE
			03/25/2010	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/663,918	WILSAK ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	/Robert James Popovics/	1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 08 January 2010.

2a) This action is **FINAL**.                            2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1,2,5-41,44,45 and 48-52 is/are pending in the application.

4a) Of the above claim(s) 17-39 and 50-52 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1,2,5-16,40,41,44,45,48 and 49 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

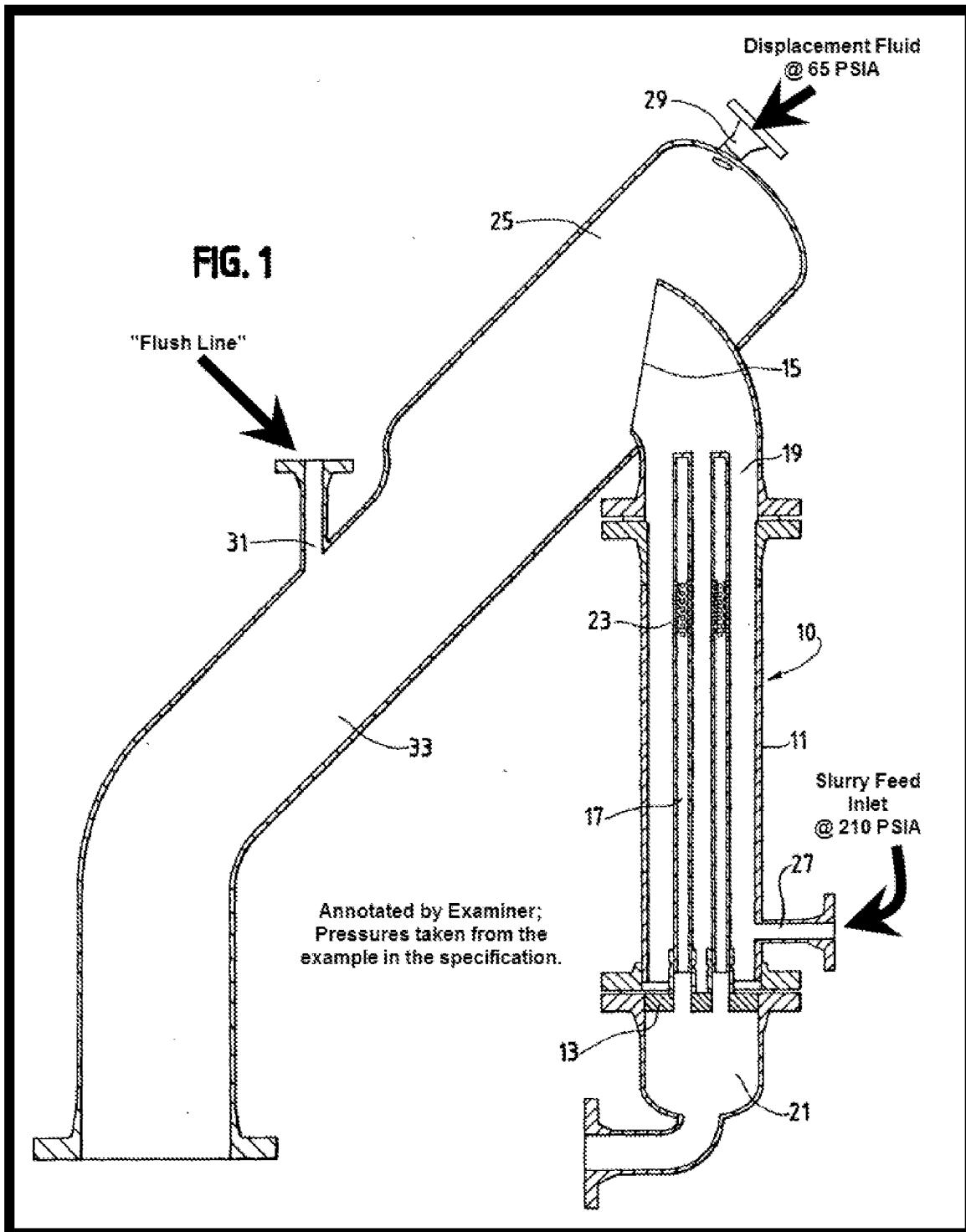
4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.

5) Notice of Informal Patent Application

6) Other: \_\_\_\_\_.

### DETAILED ACTION

Figure 1 Annotated in View of The Example



***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

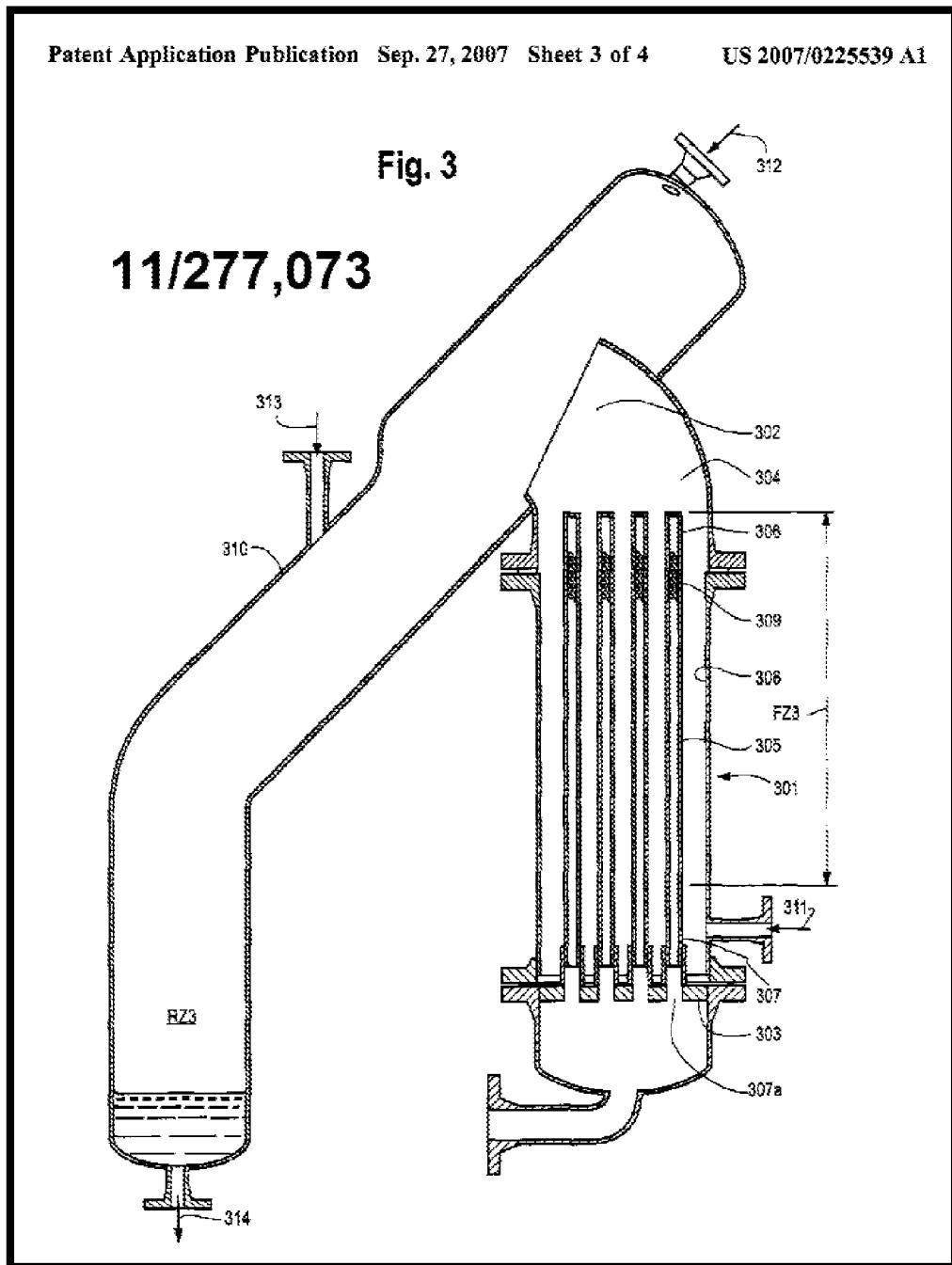
The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such **full, clear, concise, and exact terms** as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims **1,2,5-16,40,41,44,45,48 and 49** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the **enablement** requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicant has failed to teach those skilled in the art how a displacement fluid entering through nozzle 29 would be caused to flow in a manner that would displace at least a portion of liquid from a slurry feed, i.e.:

wherein the displacement fluid is insoluble in the slurry feed components and displaces at least a portion of the liquid from the slurry feed past the filter and into the lower concentration zone to produce a filtrate in the lower concentration zone.

In this regard, it is noted that the only apparatus disclosed to accomplish this step is Fig. 1, which discloses an open chute 33. As such, it is unclear how the above stated step would be accomplished. It is axiomatic that a fluid under pressure will follow the path of least resistance. Referring to Fig. 1, that would be chute 33.

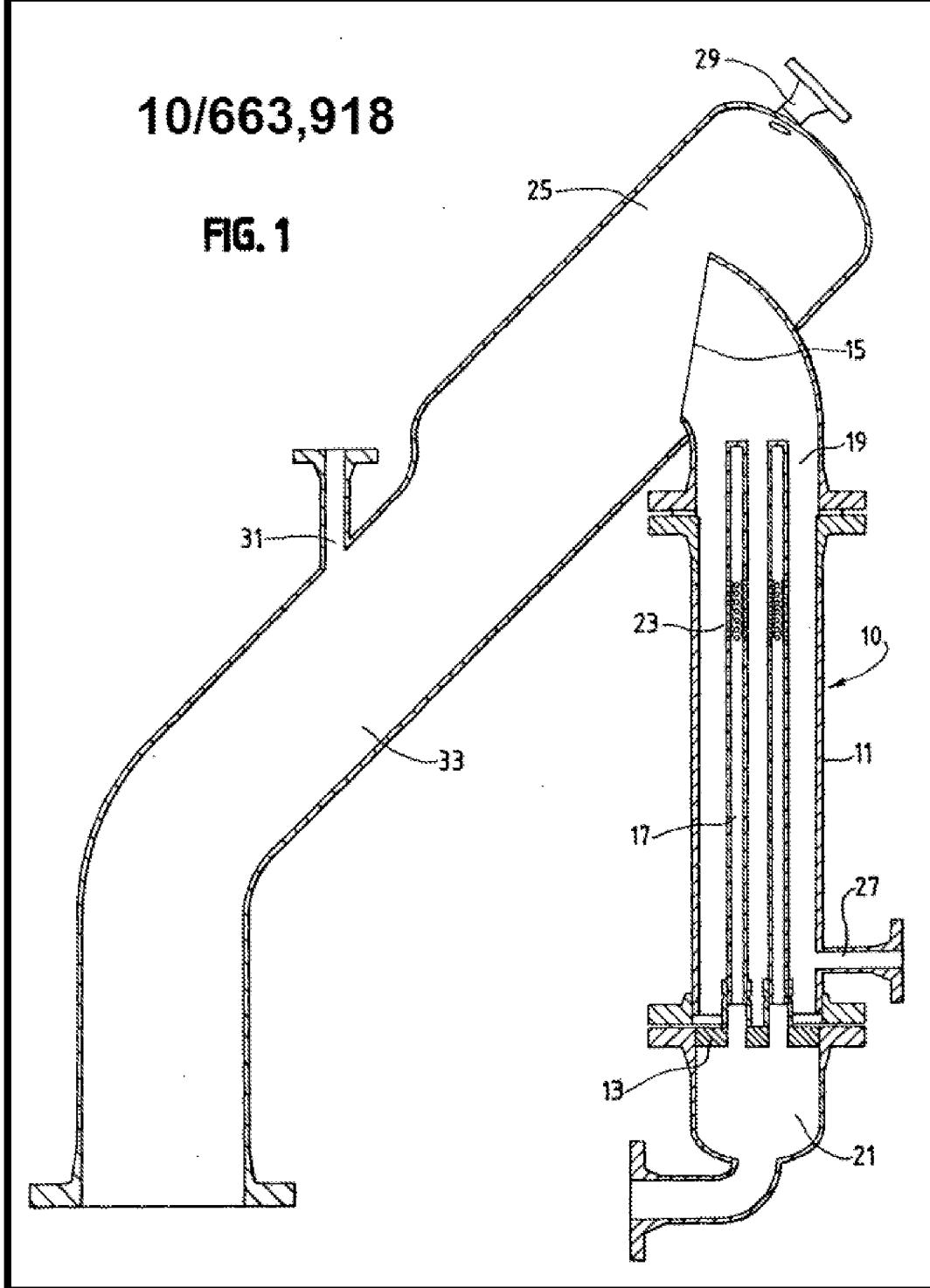
Claims **1,2,5-16,40,41,44,45,48 and 49** are rejected under 35 U.S.C. 112, first paragraph, because the **best mode** contemplated by the inventor has not been disclosed. Evidence of concealment of the best mode is based upon **Figure 3 of US 2007/0225539 A1**.



Comparing Figure 3 of US 2007/0225539 A1 with Fig. 1 of the instant disclosure

10/663,918

FIG. 1



it would appear that something is missing. Specifically, there is no means disclosed for controlling the pressure at the open end of chute 33.

***Response to Arguments***

Applicant's arguments filed **January 8, 2010** have been fully considered but they are not persuasive. Applicants' arguments against the enablement rejection are not found persuasive. Applicants' arguments assume the presence of "**rotary dump valves.**" A discussion of such valves could not be found in the originally filed specification.

After considering the pressures set forth in the sole example, it is unclear how any displacement fluid at 65 PSIA will simultaneously flow down filter column 10, when slurry at 210 PSIA is being introduced thereto via slurry feed inlet 27. Previously, Applicants trivialized the controls/valves necessary to practice the invention, citing to Hybritech. Unfortunately, the undersigned disagrees, considering those controls essential to the practice of the invention. Applicants' arguments, citing to the sole example, only serve to bring more questions to the surface. What would permit flow in a direction from a lower pressure (e.g., 65 PSIA) to a region of higher pressure (e.g., 210 PSIA)?

Applicants' originally filed specification fails to comply with the first paragraph of Section 112 which requires "**full, clear, concise, and exact terms.**"

As for the best mode rejection, Applicants asked the Examiner "***to review MPEP 2165.03,***" and so it was done. That review was revealing, for Applicants omitted a very important sentence when quoting from the section.

## **2165.03 Requirements for Rejection for Lack of Best Mode [R-1]**

### **ASSUME BEST MODE IS DISCLOSED UNLESS THERE IS EVIDENCE TO THE CONTRARY**

The examiner should assume that the best mode is disclosed in the application, unless evidence is presented that is inconsistent with that assumption. It is extremely rare that a best mode rejection properly would be made in *ex parte* prosecution. The information that is necessary to form the basis for a rejection based on the failure to set forth the best mode is rarely accessible to the examiner, but is generally uncovered during discovery procedures in interference, litigation, or other *inter partes* proceedings.

Serial No. 10/663,918

Docket No. 37512-00

The Examiner is asked to review MPEP 2165.03.

"It is extremely rare that a best mode rejection properly would be made in *ex parte* prosecution. The information that is necessary to form the basis for a rejection based on the failure to set forth the best mode is rarely accessible to the examiner, but is generally uncovered during discovery procedures in interference, litigation, or other *inter partes* proceedings . . . . Unless the examiner has evidence that the inventors had information in their possession (1) at the time the application was filed (2) that a mode was considered to be better than any others by the inventors . . . . there is no proper basis for a best mode rejection." Emphasis added.

The Examiner simply has no evidence to support his allegation. The application, US 2007/022539, was filed 2 1/2 years after the filing the present application, and therefore the Examiner simply has no evidence the information was in the applicants' possession at the time the application was filed. Further, there is no evidence which mode the inventors considered to better than any others.

Granted, Applicants did not "**present**" evidence "inconsistent with that assumption," in their instant application, the discovery of 11/277,073, by the Examiner, forced it to be considered. It is submitted that the discovery of 11/277,073 negated the assumption that the Examiner had previously been made with respect to disclosure of "**best mode**."

When comparing the disclosure of an operable system to that of an inoperable system (i.e., "non-enabled disclosure"), the ultimate conclusion as to which one constitutes the "**best mode**" is inescapable.

***Non-Compliant Claims***

Several claims are listed using the status identifier "**Canceled**," yet the text also appears. The text of canceled claims should not appear. Any future claim listing should delete the text of these canceled claims.

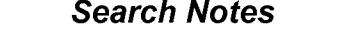
***Conclusion***

This is a **RCE** of applicant's earlier Application No. **10/663,918**. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to /Robert James Popovics/ at telephone number (571) 272-1164.

**/Robert James Popovics/  
Primary Examiner  
Art Unit 1797**

<b>Search Notes</b> 	<b>Application/Control No.</b>	<b>Applicants</b>
	10/663,918	<b>WILSAK et al.</b>
	<b>Examiner</b> <b>Robert James Popovics</b>	<b>Art Unit</b> <b>1797</b>

SEARCH NOTES (INCLUDING SEARCH STRATEGY)		
	DATE	EXMR
<b>Text Search Conducted.</b>	<b>6-12-06</b>	<b>RJP</b>
<b>Text Search Conducted.</b>	<b>8-4-08</b>	<b>/RJP/</b>
<b>Text Search Conducted.</b>	<b>12-19-08</b>	<b>/RJP/</b>
<b>Text Search Conducted.</b>	<b>5-5-09</b>	<b>/RJP/</b>
<b>Text Search Conducted.</b>	<b>3-22-10</b>	<b>/RJP/</b>